1771

Patent
Docket No: 56647US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Jacob J. Liu, Timothy O'Leary, Ned Johnson and Bruce Kluge
Group Art Unit: 1771
Serial No.: 09/849,147
Filed: May 4, 2001
Examiner: Daniel R. Zirker
For: REPOSITIONABLE ADHESIVE LABEL FOR OPTICAL RECORDING MEDIA

CERTIFICATE OF MAILING
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8/28/02 — Dea K. Crner
Date — Signature

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Dear Sir:

This response is to the Office Action mailed July 31, 2002. Claims 1-14, 15-17, and misnumbered 19 have been restricted under 35 U.S.C. § 121 as follows:

I. Claims 1-14 are said to be drawn to a repositionable label, classified in Class 428, subclass 343, and

II. Claims 15-17, and misnumbered 19, are said to be drawn to an optical recording medium in combination with a printed label, classified in Class 428, subclass 355RA.

Applicants hereby elect Group I (i.e., claims 1-14) and withdrawal of Group II (i.e., claims 15-17 and 19) with traverse, and respectfully request reconsideration and withdrawal or modification of the restriction requirement.

In Group I, Applicants broadly claim a repositionable label.

The Restriction Requirement (Paper No. 3) in Item 3 states:

> Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04 (b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04 (h)). In the instant case, the intermediate product is deemed to be useful as a

label having a wide variety of usages in many different arts and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Applicants submit the Groups I and II claims are so interrelated that a search of one group of claims will reveal art to the other. Moreover, the classification of Groups I and II claims in different subclasses is not sufficient grounds to require restriction.

Were restriction to be effected between the claims in Groups I and II, a separate examination of the claims in Groups I and II would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I and II would have to be as rigorous as when only the claims of Group I were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups I and II, it would place an undue burden by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting two applications and maintaining two patents.

Respectfully submitted,

By _____
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